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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,058	07/25/2006	Ulrike Wachendorff-Neumann	CS8786/BCS033016	2145

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BAYER CROPSCIENCE LP
Patent Department
2 T .W. ALEXANDER DRIVE
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER	
CHOI, FRANK I	

ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
09/03/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

blair.wilson@bayercropscience.com
pamula.ramsey@bayercropscience.com
destiny.davenport@bayercropscience.com

Office Action Summary	Application No.	Applicant(s)	
	10/576,058	WACHENDORFF-NEUMANN ET AL.	
	Examiner	Art Unit	
	FRANK I. CHOI	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19,21,25 and 30-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19, 21, 25, 30-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/23/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Examiner notes that the prior office action inadvertently included an objection to color drawings. As there are no color drawings the objection is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19, 21, 25, 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/010149.

The claimed invention is directed to synergistic combinations of penflufen with other antimicrobial agents, treatment of plants and seeds, including transgenic plants and seeds to control phytopathogens.

WO 03/010149 discloses penflufen can be used for controlling fungi and bacteria on crops, including seeds, including transgenic plants and seeds, can be combined with surfactants and extenders, and with other known fungicides, bactericides, acaricides, nematicides or insecticides, including azoxystrobin and azaconazole in which in many cases synergistic activity can be obtained (Page 29, lines 25-30, pages 30-46)

WO 03/010149 discloses penflufen in the treatment of plants and seeds, including transgenic plants and seeds to control fungal and bacterial infections, combinations with surfactants and extenders and combinations with other antimicrobials. The difference between WO 03/010149 and the claimed invention is that the prior art does not expressly disclose the

synergistic combination of penflufen with the specifically claimed additional active agents. However, the prior art amply suggests the same as WO 03/010149 discloses combinations with one of more of the claimed other active agents, including azoxystrobin and azaconazole and that in many cases said combinations can be synergistic. As such, one of ordinary skill in the art would expect that the combinations would be effective in treating phytopathic infections of plants and seeds. The Applicant has not provided evidence from which it can be concluded that every claimed combination would be expected to exhibit synergy. As such, although the prior art does not expressly indicate which combinations would be synergistic, since the combinations themselves are suggested by the prior art, the prior reads on the claimed invention.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the cited reference.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

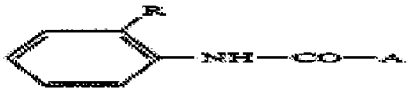
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19, 21, 25, 30-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 14-16 of U.S. Patent No. 7,538,073 in view of Eicken et al. (US Pat. 5, 438,070), the Applicant's admission, Eicken et al. (US Pat. 5,480,897) and Ding et al. (US Pat. Pub. 2002/0134012).

Claims 1-12, 14-16 of U.S. Patent No. 7,538,073 disclose pyrazolycarboxanilides, including N-[2-(1,3-dimethylbutyl) phenyl]-5-fluoro-1,3-dimethyl-1H-pyrazole-4-carboxamide, and its use in controlling phytopathogenic fungi, combination with extenders and/or surfactants and application to the habitat of the fungi.

Eicken et al. ('070) discloses anti-fungal carboxanilides of formula (1) (Column 1).

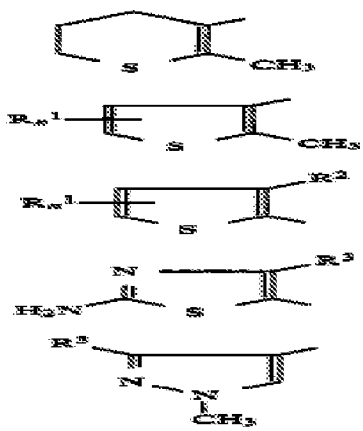
The present invention relates to carboxanilides of the formula I



where the substituents have the following meanings:

R is C_3–C_{12}-alkyl, C_2–C_{12}-alkoxy, C_3–C_{12}-alkenyl, C_3–C_{12}-alkenyloxy, C_3–C_6-alkynyl, C_3–C_6-alkynyloxy, where these groups can be partially or completely halogenated; C_3–C_7-cycloalkyl, C_5–C_7-cycloalkenyl, C_3–C_7-cycloalkyloxy or C_4–C_7-cycloalkenyloxy, where these rings can carry one to three C_1–C_4-alkyls; phenyl, which can carry one to five halogens and/or one to three of the following radicals: C_1–C_4-alkyl, C_1–C_4-haloalkyl, C_1–C_4-alkoxy, C_1–C_4-haloalkoxy, C_1–C_4-alkylthio or C_1–C_4-haloalkylthio;

A is a cyclic radical from the group consisting of the formulae A1 to A5:



where the substituents have the following meanings:

R^1 is hydrogen or C_1–C_4-alkyl;

R^2 is halogen or C_1–C_4-alkyl;

R^3 is C_1–C_4-alkyl or C_1–C_4-haloalkyl;

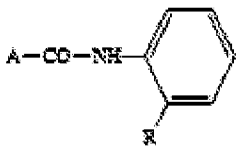
n is 1 or 2, where the radicals R^1 can be different if the value of n is 2.

It is disclosed that R can be straight chain or branched and can include 1,3-dimethylbutyl, 3,3 dimethylbutyl, and 1,2,2-trimethylpropyl (Column 4, lines 54-68). It is disclosed that compounds of formula (I) are effective for protecting plants and that formulations can be prepared with extenders and emulsifies (Column 18, lines 9-64). It is disclosed that the active ingredients may also be mixed with other microbicides, for example, 2,4,5,6-tetrachloroisophthalodinitrile, and that in many instances a synergistic effect is achieved (Column 20, lines 38-68, Column 21, lines 1-59).

The Applicant admits that the present invention relates to the combination of known carboxamides and known fungicidally active compounds, including strobilurins, triazoles, sulphenamides, valinamides, carboxamides, dithocarbamates, acylalanines, anilinopyrimidines, benzimidazoles, carbamates, dicarboximides, guanidines, imidazoles, morpholines, pyrroles, phosphonates, phenylethanamides, fungicides (including chlorothalonil), (thio)urea derivatives, triazolopyrimidines, idodochromones and biphenylcaboxamides (Specification, page 1, page 13, lines 28-31, pages 14-37, page 38, lines 1-10).

Eicksen et al. (‘897) discloses an anilide derivative of having the general formula which is effective as a fungicide (Column 1, Column 33, lines 16, Columns 31, 32, Column 33, lines 1-15):

The present invention relates to the use of anilide derivatives of the general formula



where A has the following meanings:

pyridin-3-yl substituted in the 2-position by halogen, methyl, trifluoromethyl, methoxy, methylthio, methylsulfinyl or methylsulfonyl,

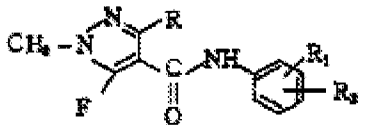
phenyl substituted in 2-position by methyl, trifluoromethyl, chlorine, bromine or iodine,

2-methyl-5,6-dihydropyran-3-yl, 2-methyl- 5,6-dihydro-1,4-oxathiin-3-yl, 2-methyl-5,6-dihydro-1,4oxathiin-3-yl-4-oxide, 2-methyl-5,6-dihydro-1,4-oxathiin-3-yl-4,4-dioxide; 2-methyl-furan-3-yl substituted in the 4- and 5-positions by hydrogen or methyl; thiazol-5-yl substituted in the 2- and 4-positions by hydrogen, methyl, chlorine or trifluoromethyl; thiazol-4-yl substituted in the 2- and 5-positions by hydrogen, methyl, chlorine or trifluoromethyl; 1-methylpyrazol- 4-yl substituted in the 3- and 5-positions by methyl, chlorine or trifluoromethyl; or oxazol-5-yl substituted the 2- and 4-positions by hydrogen, methyl or chlorine, and

R has the following meanings: unsubstituted or halogen-substituted C_2–C_{12}-alkyl, unsubstituted or halogen-substituted C_3–C_{12}-alkenyl, C_3–C_8-alkynyl, unsubsti-

It is disclosed that R can be straight chain or branched and can include 1,3-dimethylbutyl, 3,3 dimethylbutyl, and 1,2,2-trimethylpropyl (Column 1, lines 65-68). It is disclosed that compounds of the general formula are effective for protecting plants or seeds of plants and that formulations can be prepared with extenders and emulsifies (Column 33, lines 16-34). It is disclosed that the active ingredients may also be mixed with other fungicides (Column 35, lines 55-68, Column 36, Column 37, lines 1-45).

JP 63-48269 discloses a fungicide having the following formula:



Where R is methyl or ethyl and R1 and R2 are each H, halogen or lower—alkyl or alkoxy (Columns 1, 2).

Ding et al. disclose that fungicidal treatment of seeds reduces the number of separate filed passes that a farmer must make to prepare for, plant and raise a crop (Paragraph 0007). It is disclosed that the treated seeds can be transgenic seeds (Paragraph 0033).

The difference between the claims of U.S. Patent No. 7,538,073 and the claimed invention is that claims of said US Patent do not expressly disclose combining synergistically with other fungicides and treatment of plants, seeds, including transgenic plants and seeds. However, the prior art amply suggests the same as Eicken et al. (US Pat. 5, 438,070) discloses the synergistic combination of similarly structured carboxanilides with other fungicides in the treatment of plants, the Applicant acknowledges that the claimed other fungicides are known in the art, Eicken et al. (US Pat. 5,480,897) discloses the combination of similarly structured carboxanilides with other fungicides in the treatment of plants and seeds and Ding et al. (US Pat. Pub. 2002/0134012) discloses that transgenic seeds can be treated and that this reduces the total amount of pesticides used during the planting and growing of the crop. As such, one of ordinary skill in the art would expect that the compounds disclosed in the claims of '073 patent could be effectively and synergistically combined with the presently claimed other fungicides and that the same would be effective in treating plants and seeds, including transgenic plants and seeds.

The Examiner has duly considered the Applicant's arguments but deems them unpersuasive.

The Applicant argues that the present claims are directed to synergistic mixtures. However, the Applicant has not provided evidence that each combination is synergistic or at least shown that one of ordinary skill in the art would expect that all combinations claimed would exhibit synergy based on the evidence provided. As such, since the prior art suggests the combination of the claimed compounds, the rejection is maintained.

Therefore, the claimed invention, as a whole, would have been an obvious modification of the claims of the cited patent to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the claims of the cited patent and the references.

Claims 19, 21, 25, 30-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5-15 of copending Application No. 11/997,079. Although the conflicting claims are not identical, they are not patentably distinct from each other because the both claim combinations of penflufen with azoles and/or strobilurins, treatment of seeds, control of phytophatogenic fungic, protection of transgenic plants and the use of extenders and/or surfactants.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. The Examiner maintains a flexible schedule, however, the Examiner may generally be reached Monday, Tuesday, Wednesday and Thursday, 6:00 am – 4:30 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Johann R. Richter, can be reached at (571)272-0646. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank Choi
Patent Examiner
Technology Center 1600
August 31, 2010

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616